

## **REMARKS/AGRUMENTS**

Applicant(s) respectfully traverse this rejection for the reasons set out below, and ask the Examiner for reconsideration.

### **1. Summary of the Office Action**

Claims 23, 2, 5, 7, 8, 24-33 and 35-39 stand rejected under § 103(a) as allegedly being anticipated by U.S. patent no. 6,698,020 (hereinafter “Zigmond”) in view of U.S. patent no. 5,892,508 (hereinafter “Howe”).

Claims 3 and 34 stand rejected under § 103(a) as allegedly being anticipated by U.S. patent no. 6,698,020 (hereinafter “Zigmond”) in further view of U.S. patent no. 5,892,508 (hereinafter “Howe”) and U.S. patent no. 5,907,321 (hereinafter “Grossman”).

### **2. Response to § 103 (a) Rejection**

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**ZIGMOND AND HOWE DO NOT TEACH OR SUGGEST ALL CLAIM LIMITATIONS,  
WHEN CONSIDERED SINGULARLY OR IN COMBINATION TO SUBSTANTIATE THE 35 U.S.C.  
103(A) REJECTION OF CLAIMS 23, 2, 5, 7, 8, 24-33 AND 35-39.**

Claim 23 reads as follows:

23. A method, comprising:

periodically downloading from a server selected data sets according to user profile information, the selected data sets representing information elements for display to a user during switching events;

**displaying a first one of the information elements in response to initiation of a first switching event, the first switching event being characterized by unavailability of data stream information from the server; and**

discontinuing the display of the first one of the information elements and displaying the data stream information from the server when it becomes available for such display, unless the user has initiated an interactive transaction session with a remote host by selecting an interactive element associated with the first one of the information elements in which case displaying the data stream information from the server is delayed until termination of the interactive transaction session or expiration of a predetermined period of inactivity by the user.

Zigmond discloses the following:

During display of the video programming feed, an appropriate time for displaying a selected advertisement to the viewer is indicated by a triggering event. Typically, the appropriate time coincides with advertisements that are originally carried on the video programming feed. The triggering event may be a signal carried in the video programming feed, implied by the timewise structure by the video programming feed, or based on an external mechanism, such as information contained in an electronic program guide. At the appropriate time indicated by the triggering event, the video programming feed is interrupted and the selected advertisement is displayed to the viewer using a display screen of the home entertainment system. In effect, the advertisement originally carried on the video programming feed is overwritten with the selected advertisement. Upon termination of the advertisement, the video programming feed is again displayed to the viewer.

Zigmond, 4: 36-52.

Howe discloses the following:

A system and method are described for providing interactive television services and for switching between television programs, such as to an interactive program session from another program.

Howe, Abstract.

Neither Zigmond, nor Howe, or a combination thereof disclose a method including “periodically downloading from a server selected data sets according to user profile information, the selected data sets representing information elements for display to a user **during switching events**; displaying a first one of the information elements in response to initiation of a first switching event, **the first switching event being characterized by unavailability of data stream information from the server**; and discontinuing the display of the first one of the information elements and displaying the data stream information from the server when it becomes available for such display”, as required by claim 23.

In particular, Zigmond discloses “an appropriate time for displaying a selected advertisement to the viewer is indicated by *a triggering event*”. A triggering event in Zigmond is described as “*a signal carried in the video programming feed, implied by the timewise structure by the video programming feed, or based on an external mechanism, such as information contained in an electronic program guide*”, which is distinct from “**the first switching event being characterized by unavailability of data stream information from the server**”, as required by claim 23. Thus, Zigmond fails to disclose “displaying a first one of the information elements in response to initiation of a first switching event, the first switching event being characterized by unavailability of data stream information from the server”, as required by claim 23. Howe does not disclose or even suggest these features of claim 23.

Thus, claim 23 and its dependent claims 2, 3, 5, 7, 8, and 24-30 are patentable and should be allowed.

Claim 31 requires “a digital set top box configured to (i) periodically download from the server selected data sets according to user profile information, the selected data sets being included within the data stream and representing information elements for display to a user during switching events; (ii) display a first one of the information elements in response to initiation of a first switching event, **the first switching event being characterized by unavailability of data stream information from the server**”. Thus, claim 31 and its dependent claims 32-39 are patentable and should be allowed at least for the reasons articulated with respect to claim 23.

**ZIGMOND AND GROSSMAN WERE ERRONEOUSLY COMBINED TO SUBSTANTIATE THE  
35 U.S.C. 103 REJECTION OF CLAIMS 3 AND 34.**

To determine whether this combination is proper, the source of the suggestion or motivation to combine the references must be established. If the suggestion or motivation to combine Zigmond and Grossman is dictated solely by the invention of claim 3, such combination is improper. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Although Zigmond and Grossman discuss applying transmitted advertising information to a television receiver display (Grossman, 1: 8-13; Zigmond, 4: 7-10), Zigmond and Grossman are directed at unrelated problems. In fact, the problem addressed by Zigmond and the problem addressed by Grossman are manifested during mutually exclusive circumstances. For example, Grossman allows the advertisement originally carried on the video programming feed to be overwritten with the selected advertisement (Zigmond, 4: 45-52), i.e., while a user is viewing a selected channel. In contrast, Grossman discloses the display of visual images when a user *changes* the channels, during a delay between the displays of sequentially displayed channels (Grossman 3: 41-55). Thus, because the problems addressed by Grossman and Zigmond are distinct and unrelated, there is no suggestion or motivation to combine the references that can be found in the references themselves.

In light of the above, Applicant(s) respectfully submit(s) that the rejection under 35 U.S.C. § 103 has been overcome, and withdrawal of this rejection is therefore respectfully requested.

3. **Conclusion**

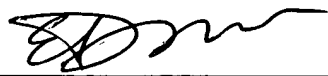
Having tendered the above remarks and amended the claims as indicated herein, Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional fees due in connection with this communication, please charge our deposit account no. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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Elena B. Dreszer  
Reg. No. 55,128

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1026  
(408) 947-8200